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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,847

04/06/2006

Masaki Tsujimoto

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05/12/2009

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EXAMINER

MCCLELLAND, KIMBERLY KEIL

ART UNIT

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1791

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,847	<b>Applicant(s)</b> TSUJIMOTO ET AL.	
	<b>Examiner</b> KIMBERLY K. MCCLELLAND	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group I, claims 1-2 in the reply filed on September 5<sup>th</sup>, 2008 is acknowledged.
2. Claims 3-4 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 5<sup>th</sup>, 2008.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 rejected under 35 U.S.C. 102(b) as being anticipated by International Application Publication No. WO00/15354 to Okada et al. as cited in U.S. Patent No. 6,500,291.
5. With respect to claim 1, the terms "supporting means", "pre-cut means", "peeling means", and "sticking means" are being treated under 35 U.S.C. 112, sixth paragraph. Okada et al. discloses a lamination device, including supporting means (2) for supporting a strip material attaching a film for forming dicing tapes stuck on one surface of a base sheet; pre-cut means (3; See Figure 3) for forming a dicing tape by forming a cut in said film in accordance with the size of said ring frame to the strip material fed

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from the supporting means; peeling means (5) for peeling off the dicing tape, located more towards the downstream of the sheet feeding direction than the pre-cut means; and pressing means (9/10) for fixing the semiconductor wafer to the ring frame by peeling sticking pressing the peeled dicing tape onto the ring frame (See Figures 1 and 14).

6. 35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language “shall be construed to cover the corresponding structure...described in the specification and equivalents thereof.” Therefore, the cutter (B; Figure 3) and the peeling roller (5; Figure 4) taught by Okada et al. reads on die cutter and peeling wedge recited in the current claim language because the features are drawn to an equivalent structure which performs the same function as the recited pre-cutting means and peeling means under 35 U.S.C. 112, sixth paragraph.

7. Examiner notes the phrases, “for fixing a semiconductor wafer to a ring frame by sticking a dicing tape to said ring frame in a state that the semiconductor wafer is disposed in an inside area of said ring frame disposed on a table”, “for supporting a strip material attaching a film for forming dicing tapes stuck on one surface of a base sheet”, “for forming a dicing tape by forming a cut in said film in accordance with the size of said ring frame to the strip material fed from the supporting means”, “for peeling off the dicing tape” and “for fixing the semiconductor wafer to the ring frame by peeling sticking pressing the peeled dicing tape onto the ring frame” are considered intended use language of the currently claimed apparatus. The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims

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directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over International Application Publication No. WO00/15354 to Okada et al. as cited in U.S. Patent No. 6,500,291 as applied to claim 1 above, and further in view of U.S. Patent No. 5,730,816 to Murphy.

10. With respect to claim 2, the terms “supporting means” and “sticking means” are being treated under 35 U.S.C. 112, sixth paragraph. Okada et al. discloses a lamination

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device, including a tension control means (4) is disposed between said supporting means (2) and a sticking means (9/10), wherein the tension control means comprises a dancer roller (4), which is movable vertically so as to allow the strip material to be fed out toward said sticking means while giving tension due to its own weight to said strip material (See Figures 1 and 14). However, Okada et al. does not specifically disclose precut means or first and second sensors for detecting a raised position and a lowered position of the dancer roller respectively.

11. Murphy discloses a label stripping apparatus, including first and second sensors for detecting a raised position and a lowered position of the dancer roller respectively (column 4, lines 5-8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the first and second sensors taught by Murphy with the dancer roller of Okada et al. The motivation would have been to provide more responsive control of the feeding and tension of the tape web.

12. Examiner notes the phrases, "so as to allow the strip material to be fed out toward said sticking means while giving tension due to its own weight to said strip material", "for detecting a raised position and a lowered position of the dancer roller respectively" and "wherein, when the first sensor detects said dancer roller at the raised position, said supporting means feeds out the strip material by a predetermined amount to lower the dancer roller, and when the second sensor detects the dancer roller at the lowered position, said supporting means stops feeding out the strip material therefrom" are considered intended use language of the currently claimed apparatus. The examiner would like to note that while features of an apparatus may be recited either

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structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114.

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 1-2 have been considered but are moot in view of the new ground(s) of rejection. Applicant's remaining pertinent arguments are addressed below:

14. Examiner notes the indication of cited structure noted by applicant is sufficient to overcome the previous 35 U.S.C. 112 rejections.

15. As to applicant's argument that the prior art does not specifically disclose pre-cut means, examiner disagrees. 35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language “shall be construed to cover the corresponding structure...described in the specification **and equivalents thereof.**” Therefore, an identical pre-cutting structure as described in the specification is not necessary to anticipate the currently claimed pre-cut means as they are recited using

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means-plus-function language. Therefore, any mechanical means which serves to cut a film reads on the currently claimed “pre-cut means”.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY K. MCCLELLAND whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly K McClelland/  
Examiner, Art Unit 1791

KKM

/Philip C Tucker/  
Supervisory Patent Examiner, Art Unit 1791